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TO THE UNITED STATES PATENT OFFICE**

OFFICIAL

Applicants Docket Number:  
USST98032 US PCT

Applicants:  
BRANELLEC, et al.

Serial No.  
09/787,995

Filing Date:  
July 9, 2001

Title of Invention:  
USE OF SPECIFIC HYBRID PROMOTERS FOR CONTROLLING TISSUE EXPRESSION

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being transmitted via facsimile to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, Maria Marvich, Ph.D. at 703-872-9306, on Date of Deposit May 13, 2004  
Printed Name of Person Signing Certificate Jonas Pierre, Sr.  
Signature \_\_\_\_\_

Total Number of Pages Sent: 3

Attorney: F. Aaron Dubberley  
Reg. No. 41,001  
Group Art Unit: 1636  
Examiner: MARVICH, Maria

TO: Mail Stop Patent Application  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

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| <input type="checkbox"/> Charge deposit account, in duplicate  | <input type="checkbox"/> Petition under 37 CFR _____                    |
| <input type="checkbox"/> Extension of Time Petition            | <input checked="" type="checkbox"/> Other <u>Reply to Office Action</u> |
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Aventis Pharmaceuticals Inc., Route 202-206, P.O. Box 6800, Bridgewater, New Jersey 08807, U.S.A. [www.aventis.com](http://www.aventis.com)  
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Aventis Pharmaceuticals Inc. template (March 2001)

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE** CENTRAL FAX CENTER

In re Application of  
**BRANELLEC, et al.**

Examiner: MARVICH, Maria

MAY 13 2004

Art Unit: 1636

Application No.: 09/787,995

Filed: July 9, 2001

Title: **USE OF SPECIFIC HYBRID  
PROMOTERS FOR CONTROLLING  
TISSUE EXPRESSION**

**TELEFAX CERTIFICATE**

I hereby certify that this correspondence is being  
transmitted via facsimile to the Commissioner for  
Patents, Alexandria, VA 22313, on

May 13, 2004

Date of Transmission

Signature *John H. Hall, Sr.*

**REPLY TO OFFICE ACTION**

Mail Stop PCT  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the final Office Action dated February 13, 2004 for the above-identified application, Applicants respectfully request withdrawal of the finality of the Office Action and traverse all rejections of the claims. The Commissioner is authorized to charge any additional fees or credit any overpayment necessitated by this response to Deposit Account No. 18-1982.

Applicants respectfully request that the finality of the February 13, 2004 Office Action be withdrawn and a new Office Action be issued. Applicants have had no opportunity to evaluate or rebut the rejections contained in the Office Action, because those rejections rely on newly cited art that was not properly identified in, or transmitted with, the final Office Action.


The February 13, 2004 Office Action has attached to it two diagrams, one of which appears to be a plasmid map labeled "PASN286-56" and one of which appears to be a plasmid map labeled "pASN286-56GB". The only dates on these two attachments are dates in 2004 and appear to be facsimile transmission dates. The Office Action contains no data on the origin, date of publication or prior art status of either of these diagrams. Accordingly, Applicants cannot determine whether these

diagrams are, in fact, prior art. Furthermore, the copies of the diagrams presented with the Office Action are poor and contain illegible text and symbols. Despite these failings, the Office Action clearly relies on these diagrams to support its arguments. See, for example, the paragraph bridging pages 5 and 6 of the Office Action, which reads, in part:

"Therefore the enhancer and promoter are less than 1 kb apart. This is conveyed in the plasmid map which is attached to this office action and confirms that the hybrid promoter is as described, with no intervening sequences between the enhancer and promoter. Therefore the plasmid of Antelman et al. meets the limitations of the instant invention."

It is impossible for Applicants to reply meaningfully to the arguments contained in the Office Action because they are unable to evaluate the origin, publication date, or prior art status of the plasmid maps attached to the Office Action. Applicants aren't even able to read certain parts of the plasmid maps. Most importantly, Applicants have been offered no opportunity to evaluate the Office Action's essential implication, that these plasmid maps somehow display what one of skill in the art would have been able to determine about the plasmids disclosed in the Antelman et al reference at the time the instant application was filed. Accordingly, Applicants respectfully request that the finality of the February 13, 2004 Office Action be withdrawn and a new Office Action issued containing full information that will allow applicants to properly evaluate the art relied on in rejecting the instant claims.

Respectfully submitted,

  
F. Aaron Dubberley, Reg. No. 41,001  
Attorney/Agent for Applicant

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Aventis Docket No. USST98032 US PCT